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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,702	11/25/2003	Jonathan S. Stinson	792-64 DIV II	6272

23869 7590 02/20/2007  
HOFFMANN & BARON, LLP  
6900 JERICHO TURNPIKE  
SYOSSET, NY 11791

EXAMINER
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SWEET, THOMAS

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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# Office Action Summary

Application No.

10/721,702

Applicant(s)

STINSON, JONATHAN S.

Examiner

Thomas J. Sweet

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 30, 44, 46, 50-59 and 76-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30, 44, 46, 50-59 and 76-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments, see page 9, filed 11/27/2006, with respect to priority have been fully considered and are persuasive. The object of priority has been withdrawn.

Applicant's arguments filed 11/27/2006 have been fully considered but they are not persuasive. The phrase "consisting essentially of" does not equate with "consisting of" (limited to the claimed invention). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising."

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 30, 44, 46, 50-59 and 76-84 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Buscemi et al (US 5500013). Buscemi et al discloses a bioabsorbable endoprosthesis (18) Consisting essentially of (the same as comprising in the broadest reasonable interpretation of the claims): at least one elongate element (18) having an outer surface, the element including a bioabsorbable polymer (poly-l-lactide, col 4, line 56) adapted to undergo degradation in vivo (col 4, line 55), the element including an elongate, axially extending reservoir portion (hollow, col 4, line 47) adapted (i.e. in as much as the present invention, since the structure is the same) fully capable of collecting a by-product of the degradation of the bioabsorbable polymer (i.e. since it is hollow, by-products "may at least partially collect", such as disclosed by the applicant); wherein the at least one element (18) occupies a total element volume including a reservoir volume (hollow space) occupied by the at least one reservoir portion, and the reservoir volume is at least about ten percent of the total element volume (col 4, lines 60-67, .2 mm fiber with a .025 to .1 mm wall is 0-56.25% which encompasses about 10-40%) .

With regard to claim 51, the at least one elongate element is formed into a tubular, radially expandable structure (such as figs. 1 and 3).

With regard to claims 52 and 54, the at least one elongate element (18) comprises a first plurality of elements helically wound (braided, col 4, line 43) about an axis in a first direction, and a second plurality of elements helically wound about the axis in a second direction opposite the first direction to form multiple crossings with the first plurality of the elements (i.e. at any point along a braid there will be "an axis" and the three or more elements required to make a braid helically wind as claimed).

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With regard to claim 53, Buscemi et al remains silent as to the specific crossing angles of the braid ranging from about 120 degrees to about 150 degrees. Applicant has not disclosed that having the crossings extending at this range of angles solves any stated problem or is for any particular purpose. Moreover, it appears that the endoprosthesis would perform equally well with the crossings at angle of braid. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify (if not inherently encompassed by a braid) the braid of Buscemi et al such that the cross over angle ranges from about 120 degrees to about 150 degrees because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Buscemi et al.

With regard to claims 55-56, PLLA a polylactide polymer is disclosed (col 4, line 56)

With regard to claim 57, polyglycolide, an others and their combinations are disclosed as suitable biodegradable materials (col 6, lines 11-20).

With regard to claims 76-78, the examiner counts over 36 filaments in fig. 1 approximately 48. However, Applicant has not disclosed that having a specific number of filaments solves any stated problem or is for any particular purpose. Additionally, a length change is within the skill level on one of ordinary skill in the art. Moreover, it appears that the endoprosthesis would perform equally well with 10-36 filaments and/or a length of 0.25-0.75 the shown length. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the stent of Buscemi et al such that it has from 10-36 filament or 0.25-0.75 the length as shown because such a modification would have been

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considered a mere design consideration which fails to patentably distinguish over the prior art of Buscemi et al.

With regard to claim 79, Buscemi et al discloses an outward spring force but remains silent as to any specific range of force (namely 40-300 grams). Applicant has not disclosed that having a specific forces range of about 40-300 grams solves any stated problem or is for any particular purpose. Moreover, it appears that the endoprosthesis would perform equally well with any force positive range up to the vessels tolerance when fully expanded. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the stent of Buscemi et al such that it outward spring force was about 40-300 grams because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Buscemi et al.

With regard to claims 80-81, Buscemi et al includes overlapping ranges with the formula of the claims, which is considered prima facie obvious.

With regard to claims 82-84, Buscemi et al discloses braided, hollow (col 4, lines 41-49 and 60-68) and is a tubular, radially expandable structure as claimed. The formulas are discussed above regarding claims 76-78 and 80-81.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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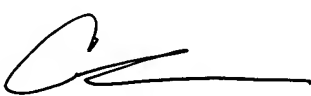
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Sweet whose telephone number is 571-272-4761. The examiner can normally be reached on 5:45am - 4:15pm, Tu-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

tjs



**CORRINE McDERMOTT**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**